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09/913,562	10/18/2001	Daniel Damson	1720	2392

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Striker Striker & Stenby  
103 East Neck Road  
Huntington, NY 11743

EXAMINER

CIRIC, LJILJANA V

ART UNIT	PAPER NUMBER
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3743

8

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/913,562

Applicant(s)  
Damson et al.

Examiner  
Ljiljana V. Ciric *LVC*

Art Unit  
3743



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 14, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Oct 18, 2001 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Mar 14, 2003 is: a) ☐ approved b) ☒ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Response to Amendment*

1. This Office action is in response to the amendment and arguments filed on March 14, 2003.
2. New claims 7 through 11 remain in the application.

### *Response to Arguments*

3. Applicant's arguments filed on March 14, 2003 have been fully considered but they are not persuasive.

Contrary to applicant's assertion, the new claims, like the canceled original claims, are still generally narrative and indefinite, failing to conform with current U.S. practice as noted in greater detail below.

As a preface to the following traversal of applicant's arguments, the examiner hereby notes that the claims in a pending application should be given their *broadest* reasonable interpretation. See In re Person, 181 USPQ 641 (CCPA 1974).

Applicant is also respectfully reminded that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, "[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

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Applicant's arguments as presented in the third through the fifth paragraphs of page 9 of the amendment and arguments filed on March 14, 2003 are not clearly understood with regard to the point being made thereby, and appear to be self-contradictory in that applicant's arguments first refer the specific location of the gas reservoir to presumably signify its importance to the invention, then note later that the heat exchanger can be arranged at any desired position relative to the fluid level of the coolant, which seems to admit that the relative locations of the reservoir and the heat exchanger are immaterial. Finally, as best can be understood, applicant's arguments appear to be drawn to various distinguishing process steps associated with the operation of the inventive heat exchanger system, but the instant invention is drawn to an apparatus and not a process of using one.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the coolant being displaced very quickly by the gas from the heat exchanger as recited in claim 7) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant also fails to indicate how, if at all, newly presented independent claim 10 overcomes the prior art of record.

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Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

#### ***Information Disclosure Statement***

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, the references listed on pages 1 and 2 of the specification do not constitute a proper information disclosure statement and have still not been considered by the examiner.

#### ***Drawings***

5. The corrected or substitute drawings were received on March 14, 2003. These substitute drawings are disapproved for the following reasons:

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the catalytic exhaust-gas converter

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arranged relative to the heat exchanger as recited in claim 11 must be shown or these features canceled from the claim. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings filed on Oct 18, 2001 are objected to under 37 CFR 1.84(h)(5) because Figure 1 show(s) modified forms of construction in the same view. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to because, there being only one drawing, the figure number "1/1" should be removed. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Specification***

8. Receipt and entry of the amended abstract is hereby acknowledged.

#### ***Claim Objections***

9. Claims 7 through 11 are objected to because of the following informalities: "Heat exchanger" [claim 7, line 1; claim 10, line 1] should be replaced with "A heat exchanger" for improved grammatical correctness and conformance with convention; "Heat exchange" [claim 8, line 1] should be replaced with "The heat exchanger"; "Heat exchanger" [claim 9, line 1; claim 11,

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line 1] should be replaced with “The heat exchanger” for improved grammatical correctness and conformance with convention. Appropriate correction is required.

***Claim Rejections - 35 U.S.C. § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 7 through 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims remain generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and contain grammatical and idiomatic errors. The claims comprise run-on limitations which are not readily comprehensible as written, and which are not clearly correlated to one another to allow one to understand exactly what is encompassed by the claims. It is not clear which portions of the claim constitute the preamble and which ones constitute the body of the claim, nor is it clear whether the claims are drawn to the subcombination of the heat exchanger only or to the heat exchanger and all associated elements of a particular vehicular system, thus rendering the metes and bounds of protection sought indefinite with regard to scope. Some of the limitations recited in the apparatus claims appear to be process or method steps (i.e., “gas is supplied into the coolant-ducts” as recited in lines 7-8 of claim 7) as opposed to merely functional language.

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More particularly, the claims still contains recitations such as “from *which*” [claim 7, line 6] without clear indication as to the element(s) referred to by the term “which”.

Also more particularly, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by “such as” and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, each of independent claims 7 and 10 recites the broad recitation of the heat exchanger being disposed “between a cooling circuit and an exhaust-gas line”, and the claim also recites the heat exchanger being disposed or arranged “in a main exhaust-gas flow” which is the narrower statement of the range/limitation.

The above is an indicative, but not necessarily an exhaustive, list of 35 U.S.C. 112, second paragraph, problems. Applicant is therefore advised to carefully review all of the claims for



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additional problems. Correction is required of all of the 35 U.S.C. 112, second paragraph problems, whether or not these were particularly pointed out above.

***Claim Rejections - 35 U.S.C. § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. As best can be understood in view of the indefiniteness of claims, claims 7, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wulf*.

*Wulf* discloses the invention essentially as claimed, including: a heat exchanger 7 or a radiator 13 between a cooling circuit and an exhaust gas line 6 of an internal combustion engine 1, at least the heat exchanger 7 being disposed in the exhaust gas flow of the exhaust gas line 6, the heat exchanger 7 each having a coolant inflow 16 and a coolant return 17, as well as an exhaust gas inlet and an exhaust gas outlet respectively disposed at either end of exhaust gas chamber 8; a gas reservoir or overflow tank 18 connected at a high point of the coolant ducts 16 and 17; a thermostatic valve 11 is readable on the shut-off device as cited in claims 7 and 11 of the instant application, and on the first shut-off device as cited in claim 10 of the instant invention, the shut-off device being disposed between the coolant inflow lines 12 and 16; the piston of the internal combustion engine 1 is broadly readable as required on the second shut-off device as cited in claim 10 of the instant invention.

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The reference thus reads on the claims.

***Allowable Subject Matter***

14. Claims 8 and 9 would be allowable if rewritten or amended, without significant broadening or other significant changes in scope, to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

15. The following additional prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Avrea, Smith, and King et al.* each discloses a vehicular engine cooling system of interest.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (703) 308-3925. While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett, can be reached on (703) 308-0101. The fax phone number is (703) 305-3463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0861.

lvc

May 30, 2003



LJILJANA V. CIRIC  
PRIMARY EXAMINER  
ART UNIT 3743